

REMARKS

Claims 6 and 8-19 are pending in the present application. With entry of this Amendment, Applicants hereby amend claims 6 and 8-19. Applicants respectfully submit the amended and the following arguments in response to the Office Action dated December 16, 2009. Reexamination and reconsideration are respectfully requested.

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter of claims 6 and 8. The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi (U.S. Patent Publication No. 2002/0078792) in view of Krauss et al. (U.S. Patent No. 4,188, 833). The Examiner rejected claims 8-11, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo (Japanese Patent Publication No. 59-069553) and in further view of Krauss. The Examiner rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo in further view of Palazzolo (U.S. Patent No. 6,605,018). The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo, Krauss, and in further view of Tsukasa (Japanese Patent Publication No. 04-203659). The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo, Krauss, and in further view of Miller (U.S. Patent No. 4,286,481). The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo, Krauss, Miller, and in further view of Hickey et al. (U.S. Patent No. 4,283,963). The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Hideyo, Krauss, and in further view of Yokel (U.S. Patent No. 3,803,934).

A. Specification

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. The Examiner cites claims 6 and 8 as lacking antecedent basis for “a first cover” and “a second cover.” The Applicants respectfully traverse this objection.

For example, on page 4, lines 32-35 of the application, the application provides: “The casing 11 is composed of a casing main body 35, a right cover 39 fixed with the casing main body 35 by means of bolts 37, a rear cover 43 fixed with the casing main body 35 by means of bolts 41.” The right cover 39 in this description provides support for the claimed term “first cover” of claim 6. The rear cover 43 in this description provides support for the claimed term “second cover” of claim 6. More specifically, the terms “first cover” and “second cover” used in claim 6 find clear support or antecedent basis in the description. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

B. Amendments to the Claims

Applicants have made amendments with respect to the claims: independent claims 6 and 8, as well as amendments to the dependent claims, claims 9-19, which depend from claim 8. Specifically, the claims have been amended to recite a “motor vehicle transfer case.” Support for these amendments can be found throughout the specification, including paragraph 0017 of the specification: “A four-wheel-drive vehicle, to which a transfer case in accordance with any embodiment of the present invention is applied...”

Applicants respectfully request entry of this after-final amendment. The amendment is sought to better claim the invention in view of the Office Action. Moreover, these amendments do not provide new matter to the application, nor do the amendments require the Examiner to conduct further search, per M.P.E.P. § 714.13(III).

C. Rejection Under § 103: Claim 6

The Examiner rejected pending claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Krauss.

This rejection is respectfully traversed, as the references fail to disclose or suggest “a motor vehicle transfer case for transferring driving force on a first shaft to a second shaft, the motor

vehicle transfer case comprising... a housing member... including a main body formed in a single unitary body.” (*Emphasis added.*)

The Applicant respectfully asserts that the combination of Kobayashi and Krauss is improper because there is no motivation to combine the references and Krauss is non-analogous art. Each argument will be addressed in order.

1. Motivation to Combine

35 U.S.C. § 103(a) states:

A patent may not be obtained though the invention is not identically disclosed or described... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The U.S. Supreme Court recently provided more clarity regarding the requirements for obviousness. In *KSR Int'l Co. v. Teleflex, Inc.*, the Supreme Court held that “one of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” 550 U.S. 398, 420-21 (2007). Conversely, “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *Id.* at 416 (*citing United States v. Adams*, 383 U.S. 39, 708 (1966)).

a. Teaching Away

The Examiner emphasizes in his response (page 13) that substituting a multiple part body for a single part body yields a predictable result. However, the art in this field was directed to the exact opposite conclusion. That is, prior art available to the field of the present invention teaches away from forming a housing main body as a single unitary body. The prior art teaches that a main body for housing motor vehicle transfer gears should be separated into two or three components for

convenience of installation thereof into a motor vehicle. This is clearly evident even in the art cited in the Office Action. For example, Fig. 1A of Palazzolo, Fig. 1 of Hickey, Fig. 4 of Yokel, Fig. 1 of Kobayashi, and Fig. 2 of Hideyo all show vehicle transfer gears in multiple components.

Indeed, many prior art references, such as JP 04-249656 (Masaharu) filed in an IDS on October 7, 2005, point out this problem:

In an existing transaxle, a case portion is divided at the centerline of an axis of a differential. More specifically, as illustrated in FIG. 4 and FIG. 5, a second case 228 attached to the first case 226 and covering the portion of a gearbox unit 204 and a centerline of a differential axis 224 of a differential unit 206; a third case attached to the second case 228 and covering the remaining portion of the differential unit 206 constitutes a transaxle case portion 230.

In light of this general knowledge, one skilled in the art would be taught away from forming a housing main body as a single unitary body. The present invention was reached contrary to general knowledge at the time.

Furthermore, in this light, Krauss's disclosure is deficient. Krauss discloses an output-side housing portion 5. (*See, e.g.*, col. 3, lines 40-41 and Fig. 2). However, Krauss fails to explicitly teach that any particular component should be formed as a single unitary body. Krauss merely discloses a component with a single unitary structure. Moreover, Krauss fails to teach any benefit obtained by the formation as a single unitary body. One skilled in the art would not see a clear reason to use the ship engine reversing gear transmission structure of Krauss to change the approach toward a housing main body for motor vehicle transfer cases.

In light of this lack of teaching, one skilled in the art would not be motivated to form Kobayashi's housing main body 9 as a single unitary body. For this reason and the reason above, Applicants respectfully request the rejection be withdrawn from claim 6.

b. Secondary Factors

In *KSR Int'l Co. v. Teleflex, Inc.*, the U.S. Supreme Court held that the designer in a particular area of ordinary skill in the art would have to see an obvious benefit to combine prior art:

The proper question was whether a pedal designer of ordinary skill in the art, facing the wide range of needs created by developments in the field, would have seen an obvious benefit to upgrading Asano with a sensor. For such a designer starting with Asano, the question was where to attach the sensor. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 424 (2007). (*Emphasis added.*)

The same applies to the present invention. If one skilled in the art were taught to form a component as a single unitary body, there must be a question of where to apply the teaching. As previously stated, any benefit given by the formation as a single unitary body was not obvious at the time of the invention. There is no rationale to choose Kobayashi's housing main body 9 from the many components as the subject for making unitary. Therefore, one skilled in the art taught by Krauss would not be motivated to modify Kobayashi to reach the claimed subject. For this reason and the reasons above, Applicants respectfully request the rejection be withdrawn from claim 6.

2. M.P.E.P. § 2144.04(V)(B) - Making Integral

This conclusion is reinforced by the above M.P.E.P. section. It provides that in 1983, the Federal Circuit found making an integral housing non-obvious. Specifically, the Federal Circuit in *Schneck v. Nortron Corp.* found that because there was "a perceived need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art." M.P.E.P. § 2144.04 (V)(B) (*citing Schneck v. Nortron Corp.*, 713 F.2d 782 (Fed. Cir. 1983)). As shown above, the need for a housing motor vehicle transfer case to have multiple parts was common knowledge at the time of the invention to address the perceived need for ease of installation into a motor vehicle. Contrary to this understanding, the present invention allows for installation, but with a unitary body. This unitary body therefore teaches away from the prior art

because it makes integral previously separate elements. For this reason and the reasons above, Applicants respectfully request the rejection be withdrawn from claim 6.

Accordingly, for the reasons set forth above, claim 6 is not anticipated or obvious in view of Kobayashi alone or in combination with Krauss.

3. *Analogous Art*

Finally, Applicants state that Krauss is non-analogous art. The Federal Circuit has discussed the “Field of Endeavor” test for analogous art:

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Bigio*, 381 F.3d 1320, 1325-26 (Fed. Cir. 2004) (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986) and *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)).

The first part of the field of endeavor test queries whether the art is from the same field. While the present invention relates to motor vehicle driveline as being understood from the amended preambles of claims and consistent with the specification, Krauss relates to a reversing gear transmission for ship engines. These arts are not from the same field, and therefore the first part of the field of endeavor test is not met. The second part of the field of endeavor test queries whether the reference is reasonably pertinent to the particular problem. A particular problem with which the present invention is involved is to overcome complexity and the large size of gear mechanisms. In contrast, problems to which Krauss is reasonably pertinent are: wide applicability; convertibility from a system having parallel-oriented shafts into a system having inclined shafts with respect to each other; and provision of a transmission which comprises interchangeable subassemblies for easy and efficient conversion to the desired system. (See col. 1, line 63-col. 2, line 4.) Krauss is not pertinent to the particular problem with which the present invention is

involved, and therefore the second part of the field of endeavor test is not met. For this reason, Applicants respectfully request the rejection be withdrawn from claim 6.

E. Examiner's Response to Arguments

The Office Action states that Applicants have not provided a definition for what the ordinary technical meaning of a "cover" is, nor does the specification provide any definition. The originally filed specification uses the term "cover" in the meaning consistent with the ordinary meaning of the term, as exemplified in Merriam-Webster's Collegiate Dictionary: "Cover, n. 2. Something that is placed over or about another thing." MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 288 (11th ed. 2004). In light of this definition, Kobayashi's element 10 that the Examiner considers as a cover does not meet the claimed "cover" because the element 10 is not an accompanying component for a housing main body, but an independent housing or a major component of a housing main body. Furthermore, the first definition listed provides examples of one object covering a separate object.

The above definition is more consistent with the specification than the Examiner's definition. (See, e.g., Figs. 1 and 3.) Indeed, *Phillips v. AWH Corp.* confirms that "'the best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.'" 415 F.3d 1303 (Fed. Cir. 2005) (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998).) Therefore, the aforementioned definition is believed to be valid.

D. Rejection Under § 103: Claim 8

The Examiner rejected claim 8 under § 103(a) as being unpatentable over Kobayashi in view of Hideyo and in further view of Krauss. The rejection is respectfully traversed.

Amended claim 8 recites "a motor vehicle transfer case for transferring driving force on a first shaft to a second shaft, the motor vehicle transfer case comprising... a casing housing... including a main body formed in a single unitary body." (*Emphasis added.*)

Kobayashi fails to disclose “a motor vehicle transfer case for transferring driving force on a first shaft to a second shaft, the motor vehicle transfer case” and “a casing housing... including a main body formed in a single unitary body,” as required in amended claim 8 for the reasons discussed above. Hideyo is similarly deficient, and it would not have been obvious to combine these references with Krauss for the reasons discussed above.

Accordingly, claim 8 is not anticipated or obvious in view of Kobayashi alone or in combination with Krauss and/or Hideyo.

E. Rejection Under § 103: Claims Dependent From Claim 8

Claims 9-19 are patentable over the references for at least the reasons set forth above with respect to claim 8.

If, for any reason, the Examiner finds the application other than in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5481 to discuss any steps necessary to place the application in condition for allowance.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 482782007600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 16, 2010

Respectfully submitted,

By 

Krista Krahn

Registration No.: 64,070

MORRISON & FOERSTER LLP

555 West Fifth Street

Los Angeles, California 90013-1024

(213) 892-5481